> "it is not necessary . . . to decide whether or not the two patents may possibly cover separate inventions . . . *We cannot now extend that monopoly under the mantle of patent No. 2,133,642.*"

The Court of Appeals for the First Circuit then reversed its ground with regard to extension of monoply and predicated its holding, rather, on "double patenting", 280 F.2d 278.[5]

The Court of Appeals for the Fifth Circuit disagreed with the Court of Appeals for the First Circuit, 255 F.2d 458 (Appendix B, p. 34, 35)

> "plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to the patent on it *alone*, to prevent its use without his consent *in any combination* and for the full 17 years." (emphasis added)

The District Court for the District of Delaware at first sided with the Court of Appeals for the Fifth Circuit against the Court of Appeals for the First Circuit, 166 F. Supp. 332, 335-6[6]

> "*In the face of the contradictory results arrived at by the First and Fifth Circuit Courts* . . . I am impressed . . . that Prof. Pierce . . . is entitled to a patent on it (the Pierce oscillator) carrying with it all the protection to which an inventor is entitled for the *full seventeen years* of the life of the patent." (parenthesis and emphasis supplied)

The District Court for the District of Delaware then re-

[6] *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1958, D.C. Del. 166 F. Supp. 332

versed itself and ruled with the Court of Appeals for the First Circuit as to "double patenting", and against the Court of Appeals for the Fifth Circuit, in the decision here at issue [7] (Tr. 6a, 15a):

> "This is at variance with the opinion of the Fifth Circuit Court of Appeals in Pierce v. Aeronautical Communications Equipment Co., 255 F.2d 458".

In the decision here in issue as to which this petition is sought, the Court of Appeals for the Third Circuit, in the light of the Supreme Court's recent holdings with regard to the relation between combination and element patents in *Aro Mfg. Co.* v. *Convertible Top Replacement Co., Inc.*, 1961, 365 U.S. 336, *declined to follow* the "double patenting" holding of its own District Court (Appendix A, p. 23).

Instead, the Court of Appeals for the Third Circuit asserted the doctrine of illegal extension of "monopoly", *without the citation of a single case to support this new proposition of law:*

> "We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the extension of this monopoly beyond its proper seventeen year term which invalidates the generic patent."

Discussion of Question I

Every week the Patent Office is granting hundreds of patents for new combinations of elements as well as for new elements alone, and in no particular order of issuance.

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[7] *Pierce* v. *Allen B. DuMont Laboratories, Inc.*, 1959, D.C. Del. 178 F. Supp. 84

There are in force well over a half a million patents for new combinations of elements, as well as for new elements by themselves, already granted without regard to order of issuance.

The conflicting and inconsistent reasoning in the decisions in *three* circuits with regard to the Pierce oscillator patent here in issue, has thrown into utter confusion the status of these element patents in the light of the combination patents that have issued involving the use of the elements.

If the answer to Question I, above, is in the affirmative, as held by the Court of Appeals for the Third Circuit, then present Patent Office practice must be promptly radically revised; and patentees should accordingly promptly be apprised by the Supreme Court that certain of their patents are thus invalid.

If, on the other hand, the answer to Question I is in the negative, as held in the first partial decision relating to the same Pierce patent here involved by the Court of Appeals for the Fifth Circuit, then the Court of Appeals for the Third Circuit should be over-ruled by the Supreme Court so that the status of combination and element patents is no longer in the serious state of doubt and confusion that has resulted from the present Third Circuit decision.

Reasons for Granting the Writ

The status of all related combination and element patents, previously granted and presently being granted each week *without regard to their order of issuance*, has been thrown into serious doubt.

Who now knows what is and is not an improper extension of a patent?

Who now knows whether the order in which related combination and element patents issue is or is not of any sig-

nificance, and thus whether present Patent Office practice is *spawning myriads of invalid patents every week?*

The Court of Appeals for the Third Circuit, indeed, has itself indicated the necessity for review by the Supreme Court in its statement (Appendix A, p. 24) that this is a

> *"case involving difficult and doubtful points of law".*

This Court should promptly resolve the conflict between the Courts of Appeals for the Third and Fifth Circuits as to whether one may or may not obtain a later-issuing element patent after first obtaining an earlier patent for a combination employing such elements.

This Court should make plain, moreover, whether the Court of Appeals for the Third Circuit is correct in its understanding that "protection" cannot legally extend more than seventeen years, or whether prior decisions of the Supreme Court to the contrary are correct.

The Supreme Court has previously pointed out, for example, in *United States* v. *American Bell Telephone Company*, 1896, 167 U.S. 224, 247,

> "It will not do to say that, because Congress has declared that seventeen years is the life of a patent, seventeen years is the limit of the possible monopoly; * * * Congress, instead of fixing seventeen, had the power to fix thirty years as the life of a patent."

This holding of the Court of Appeals for the Third Circuit is also contrary to the holding of the Supreme Court in *Leeds and Catlin Company* v. *Victor Talking Machine Company*, 213 U.S. 301, 319, that a patent for a combination and a patent for an element of the combination are different inventions, and that, consequently,

"Each invention is given the full period of seventeen years, which the statute prescribes for it."

WHEREFORE, your petitioner respectfully prays that a writ of certiorari be issued to the Court of Appeals for the Third Circuit, to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Third Circuit be reversed; and that your petitioner be granted such other and further relief in the premises as may be just and proper.

Respectfully submitted,

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Appendix A

UNITED STATES COURT OF APPEALS
THIRD CIRCUIT

No. 13279.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,
APPELLANT,
v.
ALLEN B. DU MONT LABORATORIES, INC.

Argued Oct. 7, 1960 and May 22, 1961.

APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

Before BIGGS, *Chief Judge*, and HASTIE and FORMAN, *Circuit Judges*.

OPINION OF THE COURT.

(Filed November 29, 1961)

By HASTIE, *Circuit Judge*.

This appeal has been taken from a judgment of a district court in a patent infringement suit. The trial court held that claims 3, 26, 40, 51, 52, 54-56, and 61-68 of Pierce Patent No. 2,133,642 were invalid for double patenting over the earlier Pierce Patent No. 1,789,496.[1] D.Del.1959, 178 F.Supp. 84. For convenience the numbers of the two patents will be designated throughout this opinion as "'642" and "'496".

Patent '496 was issued in 1931 on an application filed in

[1] While the pleadings and the trial covered alleged infringement of several related patents, appellant has elected to base this appeal solely upon controverted questions as to the validity and the infringement of '642, which is the basic patent.

1928. It expired some six years before the 1954 filing of the present suit. Patent '642 was issued in 1938 after a considerable history which will be detailed later. That patent expired after the filing, but before the trial, of this case.

I

A preliminary question must be decided because the inventor George Washington Pierce, who filed this complaint, died before trial. Over the objection of the defendant, the court ordered that Pierce's widow and executrix, Helen Russell Pierce, be substituted as plaintiff. D.Del.1957, 154 F.Supp. 368. Although the defendant prevailed on the merits below, it urges as appellee in this court that we need not and should not reach the merits of the appeal, but rather should rule that the cause of action was extinguished by the death of the original plaintiff. This jurisdictional problem is our first concern.

Appellee's argument, that a cause of action for damages for infringement of a patent, which has expired since that infringement, does not survive the death of the owner of the patent, proceeds in two steps. First, it is pointed out that property in patents exists solely by virtue of federal statutory law and that the incidents of that property are refined and determined by the patent statutes. This is the principle of Crown Die & Tool Co. v. Nye Tool & Machine Works, 1923, 261 U.S. 24, 43 S.Ct. 254, 67 L.Ed. 516. Second, it is argued that, since causes of action for patent infringement thus depend upon federal statutes for existence and definition, they must lapse with the death of the patent owner, unless a federal statute affirmatively provides for their survival. This is a non sequitur. Certainly, no such conclusion is required by the Crown Die case, which did not involve the problem of the effect of the death of a patentee upon the statutory right to collect damages for past infringement. Moreover, it is a necessary, if not articulated,

premise of appellee's argument that some rule or principle of law outside of the patent statutes cuts off the cause of action when the patent owner dies. This must be the case simply because the patent law itself gives no guidance on this question. Whether the conclusion shall be that the right survives or that it does not, the controlling rule must be derived from a source other than the patent statutes.

In practice, federal courts, required to decide whether various federal statutory causes of action survive, have been explicit and consistent in holding that, where the right creating statute says nothing about survival, resort to common law conceptions as evolved in English and American decisions is appropriate. Van Beeck v. Sabine Towing Co., 1937, 300 U.S. 342, 57 S.Ct. 452, 81 L.Ed. 685; Schreiber v. Sharpless, 1884, 110 U.S. 76, 3 S.Ct. 423, 28 L.Ed. 65; Sullivan v. Associated Billposters & Distributors, 2d Cir., 1925, 6 F.2d 1000, 42 A.L.R. 503; Walsh v. New York, N. H. & H. R. R., C.C.D.Mass.1909, 173 F. 494, aff'd, 1912, 223 U.S. 1, 32 S.Ct. 169, 56 L.Ed. 327. Such inquiry discloses a common law rule of survival, originally applied to a limited group of damage claims for tortious invasion of property rights, but subsequently broadened toward sanctioning the survival of claims for redress of injuries to monetary interest generally. Van Beeck v. Sabine Towing Co., supra; Kirk v. Commissioner of Internal Revenue, 1st Cir., 1950, 179 F.2d 619, 15 A.L.R.2d 1031.

This approach has resulted in rulings that various federal statutory causes survive without statutory stipulation. The question of survival arises frequently in civil suits for injury to business caused by violations of the antitrust laws. These claims are held to survive. Barnes Coal Corp. v. Retail Coal Merchants Ass'n, 4th Cir., 1942, 128 F.2d 645; Moore v. Backus, 7th Cir., 78 F.2d 571, 101 A.L.R. 379, cert. denied, 1935, 296 U.S. 640, 56 S.Ct. 173, 80 L.Ed. 455; Sullivan v. Associated Billposters & Distributors, supra. In

a different area, the Supreme Court has held, and this court has recognized, that a dependent's right under the Merchant Marine Act, 46 U.S.C.A. § 688 and the Federal Employers' Liability Act, 45 U.S.C.A. § 51 et seq. to recover the pecuniary loss he has suffered through the death of the decedent, survives the death of the dependent and may be exercised by his administrator. Van Beeck v. Sabine Towing Co., supra; Wade v. Regala, 3d Cir., 1959, 270 F.2d 280, 284.[2]

Of course, the principle "that a patent is property, protected against appropriation * * * by individuals * * * has long been settled." See Hartford-Empire Co. v. United States, 1945, 323 U.S. 386, 415, 65 S.Ct. 373, 387, 89 L.Ed. 322. For purposes of survival we can see no reason for putting actions for damage suffered through patent infringement on a different basis from the above cited invasions of other property rights.

As a separate point appellee argues that the often stated rule that penal claims do not survive is applicable here because the patent statute under which this suit is brought authorizes the recovery of treble damages. However, this argument has not prevailed in the above mentioned situation of treble damage suits under the antitrust laws. Barnes Coal Co. v. Retail Coal Merchants Ass'n, supra. Moreover, the statute involved in the present case lends itself to the separation of the basic compensatory award of actual damages from any permissible additional award of punitive

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[2] More recently, one court of appeals has extended the Van Beeck result to allow a survivor's administrator to recover for an employee's pain and suffering under Section 9 of the Federal Employers' Liability Act. Dellaripa v. New York, N. H. & H. R.R., 2d Cir., 1958, 257 F.2d 733, 72 Harv.L.Rev. 558 (1959). In so doing, however, the court completely rejected the traditional distinction between "personal" and "property" rights as concerns survival. 257 F.2d at 735. We are not asked to go this far in the present case. See also Baumet v. United States, 2d Cir., 1949, 177 F.2d 806, cert. denied, 1950, 339 U.S. 923, 70 S.Ct. 611, 94 L.Ed. 1346.

character. The statute provides primarily for the award of "damages adequate to compensate for the infringement". 35 U.S.C. § 284, 1958. Thereafter, it authorizes "the court * * * [to] increase the damages up to three times the amount found or assessed". Therefore, even assuming that the severable provision for the discretionary multiplication of damages is penal, this affords no justification for cutting off the basic right to compensatory recovery. In the posture of this case no more than that need be decided.

Appellee makes a final argument that the claim for damages for past infringement does not survive because the law does not permit a patentee to assign such a claim apart from the patent itself. However, any considerations of policy which oppose the separation of a cause of action for past infringement from the right of present enjoyment of a patent cease to be relevant after the expiration of the patent has eliminated the right of present enjoyment. It is not surprising, therefore, that such authority as there is on the point supports the assignability of a past infringement claim after the patent has expired. Ross v. City of Fort Wayne, 7th Cir., 1894, 63 F. 466; Tompkins v. St. Regis Paper Co., D.C.N.D.N.Y. 1915, 226 F. 744, aff'd 2d Cir., 1916, 236 F. 221; May v. Saginaw County, C.C.E. D, Mich. 1887, 32 F. 629. Thus, it does not help appellee to borrow the rules of assignability as guides to the determination of survival.

Finally, on this entire question of survival no policy consideration has been suggested which would make it unfair to allow a claim for past infringement to be exercised by an administrator in the interest of the estate of a deceased patentee. It is just as undesirable to permit a patent infringer to retain the fruits of his wrongdoing in this situation as it is when the patentee himself is suing. Compare Dellaripa v. New York, N. H. & H. R. R., 2d Cir., 1958,

257 F.2d 733. Thus broad policy and technical analysis both indicate that appellee's contentions are not sound.

We are the more confident of the correctness of our view of this matter because the same result has been reached in carefully reasoned opinions by two of the three district courts which have fully analyzed the problem. Armstrong v. Allen B. Du Mont Labs., Inc., D. Del. 1955, 137 F.Supp. 659; Armstrong v. Emerson Radio & Phonograph Corp., S.D.N.Y. 1955, 132 F.Supp. 176. Contra Van Choate v. General Electric Co., D.C.D. Mass. 1917, 245 F. 120.

II

We come now to the merits of the controversy. Was the trial court correct in ruling patent '642 invalid for double patenting over the patentee's earlier '496? Both patents embody Pierce's invention of a new method and apparatus utilized in electrical circuits to produce and sustain oscillations at more constant frequency than had theretofore been achievable, particularly in high frequency systems. Because inability to control frequency variations had hampered the development of high frequency radio communication, the effective incorporation of Pierce's invention in both transmitting and receiving circuits was a major achievement in an important field. Pierce's essential teaching was that the introduction of a two electrode piezoelectric crystal of his devising into a vacuum tube circuit as a mechanical vibrator accomplished the desired stabilization. This novel and unquestionably inventive device and procedure for frequency control in oscillating electrical systems will hereafter be called the Pierce oscillator. The patent infringement alleged in this case is the use of this device by appellee in two types of television transmitters, in a mobile transmitter-receiver and in a time calibrator.

As early as 1924 Pierce filed a patent application containing many claims, both broad and narrow, covering the

Pierce oscillator in various combinations and asserting many beneficial effects. In 1928, after the elimination of certain claims which are not relevant here, the still pending original application contained all of the claims which were later to be divided and granted separately in patent '496 and patent '642. Pierce then eliminated three of the remaining claims from this pending original application and incorporated them in a divisional application upon which patent '496 issued in January 1931. For present purposes it is sufficient that this first issued patent claimed a radio transmitting and receiving system wherein the new stabilizing Pierce oscillator was joined in effective combination with other elements of such a system which, admittedly, were old and familiar in the art.

More than a year before patent '496 issued, the patent office had allowed what remained of the original application, including a generic claim to the Pierce oscillator as a means of frequency stabilization in any oscillating system. Indeed, it is clear and not disputed that as early as September 1929 Pierce could have obtained a comprehensive patent, claiming and protecting his oscillator generically, merely by paying a final fee on his approved original application. However, he elected not to pay this fee within the prescribed time. Instead, he allowed this opportunity to pass and later made a timely renewal of his application as the patent law authorizes. Counsel representing the Pierce interests now tells us that Pierce thus voluntarily delayed the issuance of a patent on his generic claim because of his desire to have an interference declared with a rival inventor, one Miller, whose claims conflicted with those of Pierce and were a cloud on his title to the new oscillator. In any event, Pierce renewed his basic application in 1930. An interference was declared in 1932 and the dispute with Miller was finally adjudicated in 1938 when this court ruled that Miller had derived his alleged inven-

tion from Pierce. Miller v. National Broadcasting Co., 3 Cir., 1935, 79 F.2d 657. Thereafter, in October 1938 a patent on the remaining claims of the original Pierce application, including the generic claim to the Pierce oscillator, was issued as patent '642. The infringement alleged in the present action occurred less than seventeen years after the issuance of this patent but after the expiration of the earlier patent '496.

Both parties to the present litigation recognize that under our patent system, based as it is upon statutory monopoly limited to a seventeen year period, it is an inherent principle that an inventor is not entitled to the issuance of two patents at different times for the same invention. However, in administering the rule against double patenting it is not always clear what constitutes a single invention.

Perhaps the most frequently cited statement of the rule appears in Miller v. Eagle Mfg. Co., 1894, 151 U.S. 186, 198, 14 S.Ct. 310, 315, 38 L.Ed. 121, where the Supreme Court said:

> "* * * no patent can issue for an invention actually covered by a former patent, especially to the same patentee, although the terms of the claims may differ; that the second patent, although containing a broader claim, more generical in its character, than the specific claims, contained in the prior patent, is also void; but that where the second patent covers matter described in the prior patent, essentially distinct and separable from the invention covered thereby, and claims made thereunder, its validity may be sustained.
>
> "In the last class of cases it must distinctly appear that the invention covered by the later patent was a separate invention, distinctly different and independent from that covered by the first patent; in other

> words, it must be something substantially different from that comprehended in the first patent. It must consist in something more than a mere distinction of the breadth or scope of the claims of each patent. If the case comes within the first or second of the above classes, the second patent is absolutely void."

Since Miller v. Eagle, courts have repeatedly ruled that an inventor's separate applications embodying the same inventive concept afford proper bases for the issuance of separate patents at different times only if one of them also embodies an additional inventive concept not present in the other. In other words, the difference between the claims of the two applications must itself be inventive. Weatherhead Co. v. Drillmaster Supply Co., 7th Cir., 1955, 227 F.2d 98; In re Woodsome, 1926, 56 App.D.C. 138, 10 F.2d 1003; Palmer Pneumatic Tire Co. v. Lozier, 6th Cir., 1898, 90 F. 732; In re Copeman, 1943, 135 F.2d 349, 30 CCPA 962; In re Laughlin, 1931, 48 F.2d 921, 18 CCPA 1230; Ex parte Gump, Pat. Off. Bd.App., 1948, 83 U.S.P.Q. 351. But cf. Traitel Marble Co. v. U. T. Hungerford Brass & Copper Co., 2d Cir., 1927, 22 F.2d 259.

A typical application of this rule appears in American Bell Tel. Co. v. National Tel. Mfg. Co., C.C.D.Mass.1901, 109 F. 976, aff'd on other grounds, 1st Cir., 1903, 119 F. 893. The inventor's original patent application contained a generic claim for a novel telephone transmitter. But before final action on this generic claim, a patent was granted on a co-pending divisional application for a telephonic communication system incorporating this transmitter as its only novel element. In holding that a second patent could not lawfully be granted on the transmitter itself, the court analyzed the situation in a way that is helpful here.

"[The first patent] confers a monopoly of the transmitter with a restriction or limitation. The patent in suit confers a monopoly without restriction. The patents are nevertheless both for the 'same invention,' both in a legal and a practical sense. [The earlier patent] * * * presents the familiar case of an inventor taking a patent with an unnecessary limitation. The commissioner has exhausted his power, and cannot afterwards give him a general grant for all uses. The argument that the use of the transmitter or of the receiver alone would not infringe * * * [the earlier patent] is immaterial. It does not prove that the claim is for a * * * [different] invention, but merely that the claim does not cover all the uses which might have been covered, had the patentee not chosen to take a claim for a restricted use. That the two patents are not coextensive does not affect the application of the rule against double patenting." 109 F. at 1033.

Similarly, in the present case the Pierce oscillator is the only new and inventive feature of the combination patent '496. Moreover, the Pierce oscillator performs no different function and achieves no significantly different result in this combination than when used in any other circuit. Thus, invention inheres not in any unusual characteristic or result of the particular combination, but merely in the normal functioning of a novel component. Yet, patent '642 was issued thereafter for this very component in its general adaptation to its normal role. The controlling doctrine, elaborated in the excerpt we have quoted from the American Communication case is stated more tersely in Palmer Pneumatic Tire Co. v. Lozier, supra: "One cannot extract an essential element of his invention from a former patent, without which the former patent would not have been granted, and make it the subject of a subsequent patent."

90 F. at 744. This line of reasoning has already led the Court of Appeals for the First Circuit to find the patent in suit invalid. Pierce v. Hewlett-Packard Co., 220 F.2d 531, cert. denied, 1955, 350 U.S. 833, 76 S.Ct. 69, 100 L.Ed. 744. But cf. Pierce v. Aeronautical Communications Equipment, Inc., 5th Cir., 1958, 255 F.2d 458.

But even if the foregoing analysis is persuasive in most cases where successive patents have reflected but one inventive concept, it is argued that the second patent should be granted where circumstances beyond the applicant's control have resulted in patent office approval of a divisional application before administrative action has been completed on an earlier or simultaneously filed basic application. The point is made that such administrative delay, for which the applicant has no responsibility and over which he has no control, should not deprive him of the second partially overlapping generic claim needed to give him full protection for his invention pursuant to his initial application, even though the more restricted monopoly first granted to him is thereby extended somewhat beyond its orginal term. This argument is said to be reinforced in this case by the additional fact that Pierce eliminated the claims for a radio transmitting and receiving system from his original application and incorporated them in a divisional application only after a patent examiner had made it clear that he was unwilling to approve a patent on the original application unless there should be such division.

Where such protection for a longer time that the patent law contemplates has in fact resulted solely from administrative delay in the patent office, it may well be that a balancing of the equities will justify the allowance of both patents. Fehr v. Activated Sludge, Inc., 7th Cir., 1936, 84 F.2d 948; see Union Typewriter Co. v. L. C. Smith & Bros., C.C.W.D.Pa. 1909, 173 F. 288, 297, aff'd, 3d Cir.,

1910, 181 F. 966. Of course the patentee's equitable position is strengthened where it appears as an additional fact that the patent office itself has required a division that resulted in harmful delay.[3] In most such cases the harm of double patenting will be slight because administrative delay in allowing the earlier application is not likely to be long enough to extend the original monopoly much beyond its proper seventeen year term.

But this is not the present case. Here, the inventor, by merely paying his final fee could have obtained his generic patent more than a year before he actually obtained the narrower patent '496. He made a considered election to postpone his acquisition of the broader monopoly until he was sure that its exploitation would not be hampered by conflicting claims of a rival inventor. Yet, somewhat later, when the divisional application, which certainly was no less embarrassed than the generic one by the Miller claims, won patent office approval he paid his final fee promptly and accepted the patent. This, therefore, is not a case where administrative action prevented the inventor from having his more comprehensive application patented first, but rather where the choice has been the inventor's, dictated by his own judgment of possible economic advantage. We think these circumstances are not such as to justify an

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[3] The court below found that "at no time did the Examiner actually order a division". Rather, "seeing that he would either have to divide or suffer a final rejection by the Examiner and appeal therefrom, [the appellant] voluntarily divided". Whether a formal administrative order requiring a division must be appealed and judicially affirmed before the second of the resultant two patents is protected against a claim of double patenting and consequent invalidity, is a matter of dispute in the cases. With National Tube Co. v. Steel & Tubes, Inc., 3d Cir., 1937, 90 F.2d 52, and In re Cady, 1935, 77 F.2d 106, 22 CCPA 1190, contrast Remington Rand Business Service, Inc. v. Acme Card System Co., 4th Cir., 71 F.2d 628, cert. denied, 1934, 293, U.S. 622, 55 S.Ct. 236, 79 LEd. 710, and In re Woodsome, supra. See also In re McKee, 1935, 79 F.2d 905, 23 CCPA 717.

exception to the general rule and policy against double patenting. Cf. Miller v. Eagle Mfg. Co., supra.

One additional observation seems pertinent. It was the view of the court below that the combination patent '496 gave the patentee some measure of protection for the Pierce oscillator as such, since the oscillator was the only inventive feature of the claimed combination. Were this point essential to our decision it would be necessary to decide whether this view can be squared with recent decisions of the Supreme Court limiting the protection which a patent claiming only a particular combination can give to a constituent element of that combination. Aro Mfg. Co. v. Convertible Top Replacement Co., 1961, 365 U.S. 336, 81 S.Ct. 599, 5 L.Ed.2d 592; Mercoid Corp. v. Minneapolis-Honeywell Regulator Co., 1944, 320 U.S. 690, 64 S.Ct. 278, 88 L.Ed. 396; Mercoid Corp. v. Mid-Continent Investment Co., 1944, 320 U.S. 661, 64 S.Ct. 268, 88 L.Ed. 376. We decide merely that patent '496 protected Pierce in the use of the Pierce oscillator in radio transmitting and receiving systems. We have already pointed out that it is the extension of this monopoly beyond its proper seventeen year term which invalidates the generic patent.

One possibility of avoiding this unwarranted extension of monopoly has been suggested; namely, that the later generic patent may be held valid except that it shall not be deemed to protect such adaptations of the invention to radio transmitting and receiving as have already been covered by the earlier combination patent. A rational patent system might include such a refinement. Indeed, such a reconciliation of partially overlapping successive patents is made where an inventive difference is found to exist between their claims. E. g., Washburn & Moen Mfg. Co. v. Norwood (The Barbed Wire Patent), 1892, 143 U.S. 275, 12 S. Ct. 450, 36 L.Ed. 161. But, where there is no inventive difference between the claims of the two patents the partial

validation of the more comprehensive claims of the second overlapping patent seems unwarranted. Ex. parte Gump, supra. Rather, the patentee who has justification for supplementing his patented claims without embodying any new invention is left to the established reissue procedure for enlarging his monopoly without extending its term. See Union Typewriter Co. v. L. C. Smith Bros. Typewriter Co., 3d Cir., 1910, 181 F. 966, 969

Finally, appellee complains that the court below denied its motion for attorneys' fees under 35 U.S.C. § 285. In denying this motion the court quite properly found "that no bad faith on the part of the plaintiff has been shown". This has been a hard and fairly fought case involving difficult and doubtful points of law. It certainly discloses no such imposition or unfairness as the statute contemplates in its limited authorization of counsel fees. Cf. Hardinge Co., Inc. v. Jones & Laughlin Steel Corp., 3d Cir., 1960, 275 F.2d 37.

The judgment will be affirmed.

Appendix B

UNITED STATES COURT OF APPEALS
FIFTH CIRCUIT

No. 16830.

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of George Washington Pierce, Deceased,
APPELLANT,
v.
AERONAUTICAL COMMUNICATIONS EQUIPMENT, INC.,
APPELLEE.

Before RIVES, TUTTLE and JONES, *Circuit Judges*

May 12, 1958.

TUTTLE, *Circuit Judge.*

This is an appeal from an order of the United States District Court for the Southern District of Florida granting defendant's motion for summary judgment. The defendant is charged with infringing five patents issued to the former, now deceased, plaintiff, George Washington Pierce. The five patents in the suit comprise Nos. 2,133,642, 2,133,643, 2,133,645, 2,133,646, and 2,133,648, all issued on October 18, 1938.[1] It is alleged that the defendant a Florida corporation, is infringing plaintiff's exclusive rights under these patents by manufacturing, using and selling electrical and electromechanical vibrator systems and apparatus, including the Pierce oscillator. The summary judgment has the effect of ruling that all of the patents in issue are invalid.

[1] The complaint also alleged infringement of a sixth patent, No. 2,266,070, but plaintiff withdrew it at an earlier stage in the litigation.

The primary, but not the sole, importance of the patents involved is in the field of radio broadcasting where a need had existed for controlling the frequency of oscillating electrical circuits. Radio communication is transmitted by carrier waves which are generated from the transmitter by an alternating current of electricity flowing in and out of an antenna, composed of wires suspended in the air. Radio waves are produced when the current oscillates at a high frequency. Since communication between a sender and a receiver is possible only when both are tuned to the same frequency, it is highly desirable that the frequency of the waves sent out from a transmitter remain constant.

The problem of attaining constant frequency had existed prior to 1912 when deForrest discovered that the thermionic vacuum tube or triode could be used to generate electric oscillations. This invention provided a feasible method, and since 1912 many experts in the field searched for improved means of controlling the frequency of electric systems. The principal fault with the deForrest tube was that after the circuit had been in operation a while the elements in the circuit became heated and an undesirable amount of variation in the frequency resulted.

It was finally through the use of piezoelectric crystals that the solution came. These crystals were first noted in 1880 by Jacques and Pierre Curie. Because of their component substances, direct current when applied to them will cause the surfaces of the crystal to contract or expand. When mechanical forces are applied to contract or expand the crystal, electrical potentials of opposite sign are built up on the opposing surfaces of the crystal. Little had been accomplished in using the piezoelectric crystals in the radio field until Professor Walter G. Cady, of Wesleyan University began experimenting with the possibilities, and his work eventually attracted the attention of Pierce.

Professor Pierce discovered a means whereby the cir-

cuit could oscillate without employing any inductive coils or condensers and this could be accomplished at a remarkably constant frequency. In the Pierce oscillator, as it has come to be called in the field, a piezoelectric crystal is positioned in the input circuit, between the cathode and the grid or control electrode, or between the grid or control electrode and the anode. In the first named system the tunable resonant output circuit, consisting of the inductance coil and the condenser, is tuned to a higher frequency than the natural frequency of the crystal. Then when the system is in operation it will produce oscillations at a constant frequency determined by the natural frequency of the crystal. An important characteristic of the Pierce oscillator is that with the aid of a piezoelectric crystal having only two electrodes, it is not necessary to rely upon mechanical feed-back through a four-electrode crystal to obtain oscillations of very high frequencies such as are needed in radio transmission, and this is accomplished with the assurance that the oscillator will not oscillate except at that specific high frequency.

The Pierce oscillator is in wide use throughout the world through the licensing agreements granted by Professor Pierce, and it is acknowledged that Pierce has made a significant contribution to the field of electrical circuits and radio transmission.

At the time of inventing the Pierce oscillator, Pierce invented a number of subsidiary electrical systems for which, by application of February 25, 1924, he endeavored to obtain a single patent covering them all. Since this application included not only general claims for the use of a piezoelectric crystal to control the frequency of an oscillating system but also specific claims for the combination of a radio transmitter and receiver in which such crystals could be used, the Patent Office held that more than one invention was described in the application and

ordered a division. In compliance with this order Pierce filed a number of additional applications and several of the resulting patents are involved in this suit. One of the additional applications matured, however, on January 20, 1931, into patent No. 1,789,496, and this patent expired in 1948, before the defendant began the infringement acts complained of in this suit.

Patent No. 1,789,496, consisting of three claims, is for a radio transmitting and receiving system in combination, having a means of keeping the oscillations of both the transmitter and receiver at the same constant frequency. Claim 1 specifically mentions the use of a piezoelectric body for controlling the frequency of these oscillations and that would seem to allow the piezoelectric-crystal-controlled oscillators shown in the Cady patent No. 1,472,583 to be used as an element in the combined transmitting and receiving system. Claim 2 specifies the use of an electro-mechanical vibrator having two electric terminals in a single vacuum tube circuit, which circuit oscillates at a frequency widely independent of the other elements in the circuit. It thus apparently specifies the Pierce oscillator. Claim 3 is much broader in that it calls for any kind of prior art electro-mechanical vibrator to control the frequency.

Action on Pierce's other applications, which resulted from the order for a division was delayed because of requests for a fuller explanation of the properties of piezoelectric crystals and the failure to pay on time the required final fee. On April 20, 1930, the Patent Office issued a patent to John M. Miller covering claims 51, 52, 54, 56 and 61 to 68 inclusive of Pierce's now patent No. 2,133,642. Litigation resulted in the holding that Pierce and not Miller was the inventor of the Pierce oscillator represented by the above claims. Miller v. National Broadcasting Com-

pany, Inc., 3 Cir., 79 F.2d 657; Miller v. Pierce, 97 F.2d 141, 25 C.C.P.A., Patents, 1195. Thereafter, on October 18, 1938, the Pierce patent, No. 2,133,642, and the other four patents involved in this suit were issued.

After the expiration in 1948 of the protection provided by Patent No. 1,789,496 various business concerns began to produce electrical vibrator systems, which Pierce believed infringed his six patents, which had not, by that time expired. He entered nine suits in several different circuits against various defendants.[2]

In the instant suit the plaintiff moved for a preliminary injunction to restrain the defendant from infringing the thirteen claims of patent No. 2,133,642 which were in issue in Pierce's litigation with Miller. That motion was denied and the denial was affirmed by this Court on the grounds that there was no showing of irreparable injury or abuse of discretion. 223 F.2d 410.

Since the District Court in the issue now before us based its summary judgment upon the "reasoning" of two First Circuit Court of Appeals cases instituted by the plaintiff against others than the present defendant, it becomes necessary at the outset to consider those opinions. In American Communications Co. v. Pierce, 1 Cir., 208 F.2d 763, both parties moved for summary judgment only on claims 51, 52, 54, 55, 56 and 61 to 68, inclusive, of the basic patent, No. 2,133,642. The district court 111 F. Supp. 181, holding that the claims were valid and infringed, granted plaintiff's motion and denied defendant's motion. The Court of Appeals reversed, holding that generic patent No. 2,133,642 for an electrical system relating particularly to the use of a piezoelectric crystal for producing at a constant

[2] The eighth of those suits was Pierce v. Allen B. Du Mont Laboratories, D.C. Del., 156 F. Supp. 237. Footnote 1 therein lists the nine cases.

frequency the oscillation of such system, when read specifically on the combined transmitting and receiving systems discloses no invention distinct and separate from that of patent No. 1,789,496 and that it would not extend the plaintiff's monopoly under the mantle of patent No. 2,133,642. The Court reasoned that neither claim 1 nor claim 3 of patent No. 1,789,496, revealed any distinctive contribution to the art of frequency stabilization or radio systems; and when analyzing claim 2 with a typical claim of patent No. 2,133,642, claim 67, clause by clause, it concluded that the only significant difference indicated in the claims is the use to which the piezoelectric crystal may be put. Claim 2 of patent No. 1,789,496 narrows the operation of the crystal to the combined transmitting and receiving system whereas claim 67 of patent No. 2,133,642 more broadly states its use in any generating system. But as the radio system described by Pierce was held not to be novel in and of itself, the only inventions were the position and the method in which the two-electrode piezoelectric crystal was used in the combination.

In the other case, the district court in Pierce v. Hewlett-Packard Company, 125 F. Supp. 329, granted defendant's motion for summary judgment, declaring the above claims of patent No. 2,133,642 invalid. The Court of Appeals affirmed on the authority of the American Communications Co. case to the effect that there was double patenting in that the plaintiff's patents Nos. 1,789,496 and 2,133,642 made only one distinctive contribution, which was the novel use of the two electrode piezoelectric crystal in a single vacuum tube circuit. 1 Cir., 220 F.2d 631.

[1] As the present appeal involves all five of Pierce's patents it is apparent that there is more in issue in this suit than in the First Circuit cases and in the prior appeal in this case. The claims of patent No. 2,133,642, other than

the thirteen litigated by the Court of Appeals of the First Circuit and the claims of the remaining four patents were not in issue or even considered by the First Circuit[3] in the cases upon which the district court in this case based its holdings. As the plaintiff is entitled to a considered opinion by the district court, she should be given an opportunity to present evidence including expert testimony, documents and exhibits to prove that the nonlitigated claims involve improvements or entirely different inventions from those involved in the thirteen claims of patent No. 2,133,642. This is entirely apart from the question of correctness of the trial court's judgment as to these thirteen claims.

[2] It does appear that plaintiff, in order to secure a ruling that could have decided the validity issue in her favor, selected for the prior suits and the preliminary injunction motion in this suit certain claims of patent No. 2,133,642, and termed it the "basic patent," but this decision should not preclude her from having the courts pass upon the validity of the other patents. Since there is a different defendant in this suit no issue of res judicata or collateral estoppel can arise to bind the plaintiff by any holding or stipulation in the prior suits.

[3-5] We ought not dismiss too quickly the fact that the Patent Office Examiner ordered a division of plaintiff's original application on the ground that there were separate and distinct inventions and that six patents were granted from plaintiff's applications. As was stated in In re Cady, 77 F.2d 106, 109, 22 C.C.P.A., Patents, 1190, decisions of

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[3] It is noted that upon remand of the American Communications Company case, Judge Ford, in an unpublished opinion, Civil Action No. 51,526-F, January 31, 1958, considered the other claims and patents and held that all but patent No. 2,133,643 were void for double patenting. He, therefore, granted summary judgment for the defendant in respect to all patents except that one. The issue as to that one remains to be tried. This opinion could not have been a basis for the district court's decision which was entered May 2, 1957.

the examiner "should not be lightly overruled."[4] The burden of establishing invalidity of a patent rests upon the party asserting it and that burden is heavy. 35 U.S.C.A. § 282; Mumm v. Jacob E. Decker & Sons, 301 U.S. 168, 57 S.Ct. 675, 81 L.Ed. 983. From the status of the record regarding these patents it does not appear that these patents received the consideration from the court to which they were entitled, and the case was not, therefore, ripe for summary judgment.

In regard to claims 51, 52, 54, 55, 56 and 61 to 68 inclusive of patent No. 2,133,642, we find that the reasoning of the American Communications case and the reasoning of the Hewlett-Packard case, even if valid concerning double patenting, when placed together, do not necessarily preclude plaintiff's success in this case. It is still open to the plaintiff to contend and prove that the 1,789,496 patent was invalid for want of invention and that the 2,133,642 patent is not, therefore, void for double patenting. See O'Reilly v. Morse, 15 How. 62, 14 L.Ed. 601; Thomson-Houston Electric Co. v. Ohio Brass Co., 6 Cir., 80 F. 712. If the combination patent, No. 1,789,496 was not a valid invention, it was void *ab initio;* and having no existence there could be no monopoly relating to it and it could not be used as a predicate for double patenting. Since this case must be remanded for trial upon the merits of the above patents, plaintiff in all fairness should be allowed an opportunity to present this proof.

[6] In explaining its American Communications de-

[4] Although the Patent Act of 1952, especially section 121 of Title 35 was not in effect when the Patent Office ordered the division in this case, it does embody the policy of protecting the patentee in certain respects, including the benefit of the earlier filing date, when a division is ordered by the Office. The report from the House of Representatives Committee on The Judiciary, H.R.Rep. No. 1923, 82nd Congress, 2nd Session, 1952 states that "neither of the resulting patents can be held invalid over the other merely because of their being divided in several patents."

cision, the First Circuit Court of Appeals said in Hewlett-Packard that "the plaintiff in patents Nos. 1,789,496 and 2,133,642 made only one distinctive contribution." Further it stated:

> "The plaintiff received patent No. 1,789,496 only because of his contribution of a device which stabilized the frequency of oscillations of an electric circuit. Without this device the patent would not have been granted. The plaintiff cannot extract this essential element and make it the subject of a subsequent patent. Palmer Pneumatic Tire Co. v. Lozier, supra, 90 F. [732] at page 744, see Application of Horneman, 1952, 194 F.2d 108, 39 C.C.P.A., Patents, 809. The Pierce oscillator, the subject of patent No. 2,133,642 rather than the production of a constant beat, is the essential distinguishing feature of combination patent No. 1,789,496. See Application of Coleman, 1951, 189 F.2d 976, 38 C.C.P.A., Patents, 1156." [220 F.2d 532.]

This language suggests that patent No. 1,789,496 was not valid at all in that it was issued for a combination radio transmitting and receiving system with claims both using and not using Pierce oscillators. It can be argued that if the combination, the idea of the patent, lacks invention, the entire patent is invalid. In the situation, as in patent No. 1,789,496, in which the patentee relies upon the combination as a whole, rather than one element of it, the court should judge the combination itself as a whole. See Rieke Metal Products Corp. v. Barrel Fitting & Seal Corp., 7 Cir., 100 F.2d 259; 40 Am. Jur., Patents § 163. Where the patent is for a combination and no claim is made specifically for any one of the elements, it is conclusively presumed that the elements are old in the art or are not patentable. Richards v. Chase Elevator Co., 159 U.S. 477, 16 S.Ct. 53,

40 L.Ed. 225; Harris v. Ladd, 8 Cir., 34 F.2d 761; City of St. Louis v. Prendergast, 8 Cir., 29 F.2d 188. The district court, therefore, must ascertain whether claims No. 1 and No. 3 are too broad, and if the decision is that they describe radio systems already in the public domain, then it must proceed to determine whether the Pierce oscillator is claimed sufficiently in claim No. 2 to provide the combination with an element of novelty. If upon this analysis, invention is found lacking, patent No. 1,789,496 is invalid and there can be no double patenting.

[7] Even if the First Circuit cases have analyzed the situation correctly, they do not proceed to the point of considering the position of a patentee who has a patent on a combination invention which includes in it a patentable element. The plaintiff in this case may be able to prove that the Pierce oscillator itself is not sufficiently described in claim 2 of patent No. 1,789,496 to provide Pierce with sufficient protection. If someone had used the Pierce oscillator in a system other than the radio system described in No. 1,789,496, the plaintiff would have had difficulties, perhaps insurmountable, in proving that he was afforded protection under No. 1,789,496. A patent on a combination is a patent on the functioning whole, not on the separate parts and the fact that an unpatented element of a combination may distinguish the invention does not draw to it the privileges of a patent. Mercoid Corporation v. Mid-Continent Investment Co., 320 U.S. 661, 64 S. Ct. 268, 88 L.Ed. 376; Mercoid Corporation v. Minneapolis-Honeywell Regulator Co., 320 U.S. 680, 64 S.Ct. 278, 88 L.Ed. 396; Rowell v. Lindsay, 113 U.S. 97, 5 S.Ct. 507, 28 L.Ed. 906.

The reasoning of the above First Circuit opinions is, moreover, opposed to the basis of the division order and places the inventor in a perplexing dilemma. He must divide his claims into separate applications for separate patents to comply with the Patent Office's requirements,

but when he does this he faces the prospect of losing part of his protection, if, as in this case, the patents are issued at different times, and the double patenting argument is used against him. If, as appears to be undisputed, the plaintiff did make a significant contribution with the Pierce oscillator, he is entitled to a patent on it alone to prevent its use without his consent in any combination and for the full 17 years. If the oscillator is not specifically claimed as such in patent No. 1,789,496 that patent should stand or fall as a combination patent and have no bearing on the oscillator patent No. 2,133,642; otherwise by obeying the Patent Office's order the plaintiff is denied a portion of the protection to which he is entitled.

Since it was the Patent Office which required the division that led to the two separate patents, plaintiff does not come under the rule of Palmer Pneumatic Tire Co. v. Lozier, 6 Cir., 90 F. 732, prohibiting one from extracting an essential element of his invention from a former patent without which that patent would not have been granted and taking it for the subject of a new patent. Plaintiff originally had presented all of his claims in 1924 and because of the separation ruling and the litigation with Miller he was not awarded a final patent on the oscillator itself until 1939.[5] He is not then in the position of one who tries to extend his coverage by taking the element from the combination for a later and separate patent. Plaintiff should now be allowed to prove that the oscillator is not specifically claimed in patent No. 1,789,496, and that at most it was only protected by that patent to the extent it was used in the combination described therein.

The judgment of the District Court is reversed and the case is remanded for further proceedings not inconsistent with this opinion.

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[5] This is one of the evils to which section 121, Title 35 of the Patent Act of 1952 is directed, see footnote 4 above.